

REMARKS

Claims 5-9, 11-15, 19-26 and 76-94 are in the case. Applicant has cancelled claims 1-4, 10, 16-18 and 27-75, drawn to a non-elected species. The claims added in Applicant's last response included two claims numbered "89"; accordingly, Applicant has renumbered the second "claim 89" as "90" and the following claims as 91-94 and corrected the dependency of these claims.

Claims 5-9, 14 and 76-79 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Hilston in view of Suenaga and Roe. Claim 15 has been rejected as being unpatentable over these references further in view of Anspach.

Applicant respectfully requests that these rejections be withdrawn in view of the following remarks and the Declaration of George A. Provost, submitted herewith.

While Applicant does not disagree with the Examiner's contention that Hilston, Suenaga and Roe individually teach some of the features of Applicant's invention, it would not have been obvious at the time of Applicant's invention to combine the teachings of these references.

As explained by Mr. Provost in the Declaration submitted herewith, at the time of the invention those of skill in the fastener art would have expected to encounter significant technical difficulties in attempting to combine the teachings of Hilston, Suenaga and Roe. In the process described by Suenaga, fastener elements, or the stems of fastener elements, are molded in discrete cavities extending from the surface of a mold roll. It is well known in the art that such a method for forming male fastener products, while extremely cost effective, is also very sensitive to variations in molding parameters that can effect proper stem formation, cooling, and extraction. Resin flow rates, temperatures and pressures must be maintained at proper levels in the molding region to form useful fastener element stems. Thus, at the time of the invention Mr Provost believes that those of skill in the fastener art would have doubted that a significant modification -- such as the introduction of the undulation-forming process described by Roe -- could be made to the Suenaga process without interfering with proper stem formation. (Paragraph 6, Declaration of George A. Provost.)

Moreover, one skilled in the art would have considered forming undulations during a continuous stem-forming process to be problematic due to the complexity of the tooling that would be required to form stems and undulations side-by-side. For example, while nesting features on the opposed mold rolls would be required to form undulations, proper stem formation generally requires a flat surface opposite the stem molding cavities at a predetermined spacing from the cavities. Additionally, someone of skill in the art would have been concerned that it would be difficult to control the amount of plastic delivered to the gap between the mold rolls so as to provide sufficient resin to fill the molding cavities while also providing a sufficiently thin web to allow undulations to be simultaneously formed. (Paragraph 7, Declaration of George A. Provost.)

As noted by the court in *In re Kotzab*, "a critical step in analyzing the patentability of claims pursuant to section 103(a) is casting the mind back to the time of invention, to consider the thinking of one skilled in the art, guided only by the prior art references and the then accepted wisdom in the field." (*In re Kotzab*, 217 F.3d 1365, 1369, Fed. Cir. 2000, citing *In re Dembiczak*, 175 F.3d 994, 999.) Based on this analysis, Applicant respectfully submits that the references cannot properly be combined as proposed by the Examiner.

It is noted that Anspach, cited only for its teaching of a flap, does not supply a motivation or suggestion to combine the teachings of the other references.

Accordingly, Applicant respectfully requests that the rejections under 35 U.S.C. 103(a) be withdrawn.

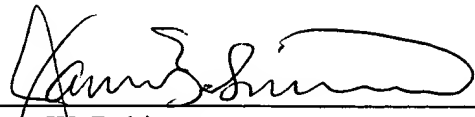
Applicant : William Clune
Serial No. : 09/808,645
Filed : March 14, 2001
Page : 11 of 11

Attorney's Docket No.: 05918-213001 / 4080

Please apply any charges or credits to deposit account 06-1050.

Respectfully submitted,

Date: February 17, 2004


James W. Babineau for Celia H. Leber
Reg. No. 40,276

Fish & Richardson P.C.
225 Franklin Street
Boston, MA 02110-2804
Telephone: (617) 542-5070
Facsimile: (617) 542-8906

20804975.doc